

REMARKS

On entry of the instant Amendment, Claims 77, 79 and 80 are pending. Claim 77 has been amended to more particularly point out the Applicant's invention. Claim 78 has been cancelled. It is respectfully submitted that an earnest attempt has been made to address all of the issues raised in the instant official action. Accordingly, it is respectfully submitted that the Application is in condition for allowance.

Objections to the Specification and Drawing

A number of objections have been made to the specification as noted in Paragraph 3 of the Detailed Action. In addition, Paragraph 2.1 of the Detailed Action relates to objections regarding Fig. 22A. A revised copy of Fig. 22A is enclosed. This figure has been revised to switch the YES and NO legends as suggested by the Examiner. Thus, the objection to Fig. 22A should be obviated.

With respect to the objections to the specification, and specifically paragraph 3A(1) of the Detailed Action, the status of the referenced applications was updated in the response to the last Office Action, mailed on March 8, 2005. However, the update is being repeated again for the convenience of the Examiner. Thus, this objection should be obviated.

With respect to Paragraph 3B(1)(a) of the Detailed Action, Fig. 22A has been revised to reconcile with the quoted specification. In addition, with respect to paragraph 3B(1)(b), the specification is being amended to reconcile with Fig. 22B. It is respectfully submitted that no new matter has been added. Thus, this objection should be obviated.

It is respectfully submitted that each and every one of the objections to the specification and drawing have been addressed. Accordingly, it is respectfully submitted that all of the objections to the specification and drawing have been overcome and should be withdrawn

CLAIM REJECTIONS-35 USC § 103

Claim 77 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunn, U.S. Patent No. 4,024,380 or Pusic, U.S. Patent No. 5,065,000 in view of Barns-Slavin, et al., U.S. Patent No. 5,117,364. It is respectfully submitted that the Gunn, Pusic, and Barns-Slavin patents do not disclose or suggest the claimed invention either singly or in combination. In particular, we agree with the assertion that neither the Gunn nor Pusic patents disclose a system which enables a customer to select a delivery service option from at least two delivery service options. The Barns-Slavin, et al. patent was cited for disclosing a system which allows a user to select a delivery service option from at least two different options.

Paragraph 5.1 of the Detailed Action opines that “it would have been obvious to one of ordinary skill in the art at the time of the invention that the mailing machine/process of either Gunn ('380) or Pusic ('000) could be modified to determine a number of ‘delivery service options’ based on user-entered shipping-related data and present the various determined ‘delivery service options’ to the user as taught by Barns-Slavin, et al. ('364).”

It is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness. As set forth by the MPEP:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference, or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations ...The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."

It is respectfully submitted that the rejection of claim 77 does not meet any of the basic criteria. First, it is respectfully submitted that there is no suggestion or motivation, either in the references themselves or in the knowledge available to modify the reference or to combine the teachings. Paragraph 5.1 merely states that the delivery service options disclosed in the Barns-Slavin, et al. patent is a "desirable feature." It is respectfully submitted that this opinion by the Examiner does not satisfy the criteria for several reasons. First, it is respectfully submitted that there is no suggestion or motivation in any of the references cited to combine and modify the references as suggested by the Examiner. As set forth in MPEP § 2143, the motivation or suggestion to combine the references must either be contained in the references themselves or the knowledge generally available to one of ordinary skill in the art. Since the motivation to combine these references is not contained within the references themselves, the question is whether mere desirability of a feature in the opinion of the Examiner satisfies the criteria whether the motivation is in the knowledge generally available to one of ordinary skill in the art at the time the invention was made. It is respectfully submitted that an opinion of the desirability of the combination probably applies to every invention. The question is not whether a feature is desirable, but whether there is any motivation or suggestion to modify the references as suggested by the Examiner. Since there is no evidence that the combination was generally known by those of ordinary skill in the art at the time of the invention, it is respectfully submitted that the criteria is not met. It is respectfully submitted that the only motivation to

combine the teachings of the Barns-Slavin patent is the instant claim, which is clearly impermissible.

It is also respectfully submitted that the second criteria of a reasonable expectation of success must also be found in the prior art. As taught by the Barns-Slavin patent, the system taught by the Barns-Slavin patent has special purpose keys for the various options. The Examiner's attention is directed to Fig. 3 of the Barns-Slavin patent, and specifically the keys generally identified with the reference numeral 100. The Gunn patent discloses a system that contains five levers, identified with the reference numbers 13-17. These levers are for simply entering a zip code. The Examiner's attention is directed to Fig. 1 of the Gunn patent. Clearly, since the device disclosed in the Gunn patent simply contains five levers, it is difficult to understand how the teachings of the Barns-Slavin patent, which requires special keys for each delivery option, could be incorporated into the Gunn system, since the Gunn system would have to be modified to include many additional keys. It is also difficult to understand whether such a modification would even work. The Pusic patent includes a keyboard 5. However, the keyboard 5, disclosed in the Pusic patent, does not include any special purpose delivery option keys as taught by the Barns-Slavin system. Moreover, there is no suggestion in either the Pusic or Barns-Slavin patent how the Pusic patent could be modified to incorporate the multiple delivery option feature disclosed in the Barns-Slavin patent. In addition, there is no suggestion in either of the references whether such a modification to the system disclosed in the Pusic patent would actually work.

Notwithstanding the claims as now amended, recite that the delivery service options are displayed. As such, even combining the teachings of the Barns-Slavin, Pusic, or Gunn patents as suggested by the Examiner does not suggest this claim limitations, since the delivery options

available are not displayed in the Barns-Slavin patent, but merely selectable by way of special keys in the keyboard. The support in the instant specification for this claim amendment can be found on page 16, lines 19-23. Thus, the references do not teach or suggest the claim limitations, as now amended to satisfy the third criteria.

For all of the above reasons, it is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness. The Examiner is accordingly requested to reconsider and withdraw this rejection.

Claims 78 and 80 have been rejected under 35 U.S.C. § 103 as being unpatentable over Pusic, in view of Barns-Slavin. Claim 78 has been cancelled. Thus, the rejection with respect to claim 78 is obviated. With respect to claim 80, this claim recites, in combination, a system that is not disclosed or suggested by either the Pusic or Barns-Slavin patents as discussed above. For all of the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 80.

Claim 79 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunn or Pusic as modified by Barns-Slavin and further in view of Allen, et al. Claim 79 is dependent upon claim 77 and recites in combination all of the features included in claim 77. As discussed above, neither the Gunn, Pusic nor Barns-Slavin, et al. patents discloses or suggests the features recited in the claims. The Allen, et al. patent was cited for disclosing a touch-sensitive CRT, but does not, otherwise, disclose or suggest the elements of claim 77 in combination.

With respect to the rejection of claim 79 and 80, it is also respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness. Indeed, as set forth above, the Examiner has failed to show that the suggestion to modify the references was suggested by the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons and the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 79 and 80.

Respectfully submitted,

KATTEN MUCHIN ROSENMAN LLP

By:



John S. Paniaguas

Registration No. 31,051

Attorney for Applicant(s)

Katten Muchin Rosenman LLP
525 W. Monroe Street
Chicago, Illinois 60661-3693
(312) 902-5200
(312) 902-1061 - facsimile
Customer No. 27160